

## REMARKS

This paper is presented in response to the non-final official action dated August 23, 2007, wherein: (a) claims 1-8, 10-12, 14-21, and 23-28 are pending; (b) all pending claims were rejected based upon a defective reissue declaration under 35 USC § 251; (c) claims 1, 4, 7, 8, 10, 12, 14, 16-18, 21, 23, 27, and 28 were rejected under 35 USC § 102(b) as anticipated by Smith et al. U.S. Patent No. 5,403,605 ("Smith"); (d) claims 2, 3, 6, 19, 20, and 26 were rejected under 35 USC § 103(a) as obvious over Smith in view of Krebs U.S. Patent No. 4,052,318 ("Krebs"); (e) claims 5, 11, 15, 24, and 25 were rejected under § 103(a) as obvious over Smith; and (f) all pending claims were rejected as lacking written description support under 35 USC § 112, ¶ 1.

Reconsideration and withdrawal of the rejections are respectfully requested in view of the foregoing amendments and following remarks.

### I. Amendments to the Claims

Claim 1 has been amended to recite "a permanent filter ... which has openings sized to filter out the fine espresso coffee grounds *having a size of 0.3 mm or less.*" (Italics indicate the claim language added by the present amendment.)

Claims 4, 7, 17, and 21 have been amended to recite "a permanent filter *having openings sized to filter coffee grounds having a size of 0.3 mm or less.*" (Italics indicate the claim language added by the present amendment.)

Support for the amendments to all five independent claims may be found, for example, at col. 1, lines 10-23 of Hilbrich U.S. Patent No. 6,016,740, indicating that espresso-type coffee makers generally have a filter sized to intercept coffee grounds having a size of 0.3 mm or less.

By these amendments, claims 1-8, 10-12, 14-21, and 23-28 remain pending, and claims 8, 13, and 22 remain canceled. There are five independent claims and 25 total claims.

### II. The 35 USC § 102(b) Rejection Is Traversed

Claims 1, 4, 7, 8, 10, 12, 14, 16-18, 21, 23, 27, and 28 were rejected under 35 USC § 102(b) as anticipated by Smith. See p. 3 of the action. The applicant respectfully traverses the anticipation rejection.

Smith discloses a coffee filter as part of a coffee brewing method. With respect to its disclosed coffee brewing apparatus, Smith incorporates by reference the disclosure of the concurrently filed, copending application to Smith, Herrick, and Bruncaj. See Smith, col. 2, line 61 to col. 3, line 2. This incorporated disclosure issued as Herrick et al. U.S. Patent No.

5,190,653 ("Herrick").<sup>1</sup> The filter includes a foraminous support sheet, preferably made of stainless steel, which support sheet provides the strength needed to support the filter element located above the support sheet. See Smith, col. 4, lines 38-41. The holes of the support sheet range from 1 mm to 2.5 mm in diameter. See Herrick, col. 3, lines 29-30.

Independent claim 1 recites "a permanent filter ... which has openings sized to filter out the fine espresso coffee grounds having a size of 0.3 mm or less." Similarly, independent claims 4, 7, 17, and 21 recite "a permanent filter having openings sized to filter coffee grounds having a size of 0.3 mm or less."

The action asserts that Smith's foraminous support sheet functions as the permanent filter recited in the claims. See p. 3 of the action. However, Smith's foraminous support sheet has openings of at least 1 mm in diameter, and the sheet therefore is not sized to filter coffee grounds having a size of 0.3 mm or less. Thus, Smith fails to disclose a permanent filter having the recited opening size, and the pending claims are not anticipated.

Accordingly, the applicant respectfully requests reconsideration and withdrawal of the § 102(b) rejection.

### III. The 35 USC § 103(a) Rejection Is Traversed

Claims 2, 3, 5, 6, 11, 15, 19, 20, and 24-26 were rejected under 35 USC § 103(a) as obvious over the combination of Smith and Krebs or over Smith alone. See pp. 4-5 of the action. The applicant respectfully traverses the obviousness rejections.

Krebs is directed to a mesh coffee filter. Krebs discloses a filter having multiple layers and has no disclosure relevant to the recited filter opening size limitation. Therefore, Krebs fails to remedy the deficiencies of Smith taken alone (see Section II above), and any combination of Smith and Krebs fails to teach or suggest all of the claim limitations.

Further, there is no motivation to modify Smith (or Smith and Krebs) to remedy the filter opening size deficiency. Notwithstanding that the foraminous support sheet of Smith might, in the abstract, function as a filter (i.e., simply because it is a flat plate with holes), the support sheet nonetheless is *intended to function as a support for Smith's filter element*, and not as a filter element itself. See Smith, col. 4, lines 38-41. Consistent with this function, Herrick instructs that the support sheet "should contain the *maximum open area* consistent with strength." See Herrick, col. 3, lines 25-27 (emphasis added). As a result, the skilled artisan would not be motivated to reduce the diameter of the holes in the support sheet (i.e., so that the support sheet would be sized to filter coffee grounds having a size of 0.3 mm or less), because such a modification would reduce the open area of the support sheet and

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<sup>1</sup> Herrick issued from Application No. 07/606,040, filed October 30, 1990. Smith issued as a continuation of Application No. 07/606,041, filed October 30, 1990.

restrict the through-flow of brewed coffee. Thus, a modification reducing the opening size in the support sheet would be contrary to a stated goal of Smith: rapidly brewing coffee with a reduced cycle time. See Smith, col. 2, lines 18-20 and Abstract.

Accordingly, reconsideration and withdrawal of the § 103(a) rejections are respectfully requested.

**IV. The 35 USC § 112, ¶ 1 Rejection Is Traversed**

Claims 1-8, 10-12, 14-21, and 23-28 were rejected under 35 USC § 112, ¶ 1 as lacking written description support. The action asserts that "there is no support in the specification for a 'metallic' filter or 'elevated' pressure." See pp. 2-3 of the action. The applicant respectfully traverses the written description rejection.

The applicant assumes that the rejection is based on the recitation of a "permanent filter" and not a "metallic filter," inasmuch as the broadening of "metallic filter" in issued U.S. Patent No. 6,016,740 to "permanent filter" was a basis for the present reissue application. In any event, there is clear support in the application as originally filed for the term "metallic filter." See p. 9 of the specification as filed (describing an embodiment including a "metallic filter 18") and claim 1 as filed (reciting a "metallic filter").

The claims reciting the terms "permanent filter" and "elevated pressure" were previously rejected in the official action dated October 28, 2004, as lacking written description support. The rejection was fully addressed by the applicant in the response filed January 28, 2005. The subsequent official action dated March 30, 2006, did not maintain the written description rejection, suggesting that the rejection based on the terms "permanent filter" and "elevated pressure" had been successfully traversed.

For completeness and conciseness, the contents of the applicant's previous response filed January 28, 2005, are hereby incorporated herein by reference, but not repeated. Briefly, however, the written description rejection is traversed for two independent reasons. First, the present action merely asserts that "there is no support" for the filter and pressure limitations, but fails to provide "reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed." MPEP § 2163.04(I)(B). Second, the terms "permanent filter" and "elevated pressure" are supported in the filed application. See claim 4 as filed (reciting a "permanent filter") and p. 8 of the specification as filed (disclosing a coffee maker that "delivers hot water under pressure").

Accordingly, reconsideration and withdrawal of the 112, ¶ 1 rejection are respectfully requested.

**V. Second Supplemental Reissue Declaration**

A second supplemental reissue declaration is submitted herewith. Paragraph 9 acknowledges the duty to disclose information material to patentability. Further, paragraph 3, a portion of which was previously incomplete due to a poor photocopy, is complete in the submitted second supplemental reissue declaration. Accordingly, it is requested that the rejection based upon the declaration be withdrawn.

**CONCLUSION**

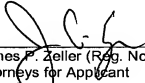
In view of the foregoing, entry of the amendments to claim 1, 4, 7, 17, and 21, reconsideration and withdrawal of the rejections, and allowance of claims 1-8, 10-12, 14-21, and 23-28 are respectfully requested.

Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, the examiner is urged to contact the undersigned attorney.

Respectfully submitted,

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November 20, 2007

  
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